

REMARKS

Claims 7-13 are pending in this application. Claims 7-13 stand rejected under 35 U.S.C. §103(a) as being unpatentable over US patent No. 5,210,526 (hereinafter Imperiali) in view of US patent application publication No. 2002/0183971 (hereinafter Wegerich) and further in view of US patent No. 4,819,658 (hereinafter Kolodner). Reconsideration of the rejections and allowance of the pending claims are respectfully solicited in view of the following remarks.

M.P.E.P. 2143.03 provides that to establish *prima facie* obviousness of a claimed invention, all the claims limitations must be taught or suggested by the prior art. All words in a claim must be considered for judging the patentability of the claim against the prior art. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending there from is nonobvious. The Applicants explain below why the cited prior art fails to satisfy this requirement.

Claim 7 is directed to a computer-based method for monitoring and carrying out a diagnosis of a technical installation comprising a plant for generating electrical power. Claim 7 recites monitoring a plurality of distinct types of machinery in the technical installation. The distinct types of machinery including rotating and non-rotating machinery. The monitoring is configured to acquire a number of temperature values and temperature information regarding the plurality of distinct types of machinery. The monitoring is configured to account for interactions that occur between at least some of the distinct types of machinery in the technical installation. Basis for the last-recited operational relationship may be found at least in paragraphs 22, 26, and 27 of the US patent application publication of the present invention.

Applicant respectfully submits that the Imperiali/Wegerich/Kolodner combination does not constitute an appropriate *prima facie* combination for rejecting claims under 35 USC 103(a). It is respectfully noted that the Imperiali/Wegerich/Kolodner combination does not teach or suggest monitoring configured to account for interactions that occur between at least some of the distinct types of machinery in the technical installation, as set forth in claim 7. Imperiali at most describes interactions between three different types of sensors. However, the claimed invention recites interactions between the machinery which is being monitored. One skilled in the art would recognize that, in the context of the claimed invention, a sensor is device that may be used for performing a monitoring action but clearly is not the machinery being monitored. M.P.E.P.

2144.08 III advises Examiners that they should clearly articulate which portions of the prior art teach or suggest the claimed invention to support a 35 USC 103(a) ground of rejection. Applicant respectfully submits that should the Examiner decide not to allow the application, any further rejection of the claims in a subsequent Office Communication should not be a final rejection, and consistent with the MPEP, such Office Communication should clearly articulate where the prior art teaches or suggests the claimed operational relationship regarding monitoring configured to account for interactions that occur between at least some of the distinct types of machinery in the technical installation, as set forth in claim 7. This request is being necessitated by the oversight of the Office Communication to follow the M.P.E.P. and is not due to applicant's arguments. In view of the foregoing considerations, it is respectfully submitted that the Examiner has not carried his burden to clearly articulate why the Imperiali/Wegerich/Kolodner combination constitutes an appropriate *prima facie* combination for rejecting claim 7 under 35 USC 103(a), and this rejection (as well as the rejection of claims depending from claim 7) should be withdrawn.

Claim 10 in part recites a data acquisition module adapted to acquire a number of temperature values and temperature information related to a plurality of distinct types of machinery of the technical installation, wherein acquisition of data performed with the data acquisition module is configured to account for interactions that occur between at least some of the distinct types of machinery in the technical installation.

It is respectfully submitted that the Imperiali/Wegerich/Kolodner combination fails to describe or suggest the structural and/or operational relationship wherein a data acquisition module is configured to account for interactions that occur between at least some of the distinct types of machinery in the technical installation, as set forth in claim 10. Accordingly, the Imperiali/Wegerich/Kolodner combination also fails to constitute an appropriate *prima facie* combination for rejecting claim 10 under 35 USC 103(a), and this rejection (as well as the rejection of claims depending from claim 10) should be withdrawn.

CONCLUSION


It is respectfully submitted that each of the claims pending in this application recites patentable subject matter and it is further submitted that such claims comply with all statutory requirements and thus each of such claims should be allowed.

The commissioner is hereby authorized to charge any appropriate fees due in connection with this paper, including the fees specified in 37 C.F.R. §§ 1.16 (c), 1.17(a)(1) and 1.20(d), or credit any overpayments to Deposit Account No. 19-2179.

Respectfully submitted,

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